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| 09/981,230 | 10/17/2001 | Steven B. McGowan | INTL-0625-US (P11956) | 5567 |

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EXAMINER

EISEN, ALEXANDER

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2674

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,230

Applicant(s)

MCGOWAN, STEVEN B.

Examiner

Alexander Eisen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 14 and 19 are objected to because of the following informalities: claim 14 states "said predetermined duration user definable", and claim 19 recites "said first loop enabled to be overwritten", which seemingly constitute incomplete sentences. The examiner suggest - said predetermined duration **being** (or is) user definable -, and - said first loop being enabled to be overwritten -. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 19-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The negative limitation in claim 19 "said first loop enabled to be overwritten **without** overwriting said second loop" does not have support in the specification as originally filed. Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd*

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mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5-8 and 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sisselman, US 2003/0007079 A1 (reference of record).

With respect to claims 1, Sisselman discloses a personal hand-held viewing device (FIG. 5) comprising an optics element (lens 310) to facilitate viewing; an image sensor to capture frames (as part of image signal processor 320, see paragraph [0029]); a storage (RAM 370) to store sequence of frames of predetermined duration (see paragraph [0032]), whereas the storage is coupled to said sensor; a display (380) coupled to said storage to display the sequence of frames; and a controller (microprocessor 350) to automatically store successive sequence of frames of predetermined duration including an earlier and later sequences, earlier and later sequences can be seen as a first loop and a second loop; said controller storing the later sequence of frames in the storage and automatically overwriting an earlier sequence and play back either said first loop in response to a user input or a second loop ([0037], FIGS. 6 and steps 620-640 in flow-chart diagram in FIG.8; also paragraphs [0033 – 0036]).

While Sisselman is not explicit about selectively saving sequences of frames and in response to a user input, it would have been obvious to one of ordinary skill in the art at the time when the invention was made that saving of those sequences is clearly selective based on a user input, when a user requests to display a predetermined number of such frames by selectively isolating that predetermined number of frames in one loop and leaving the other memory for storing current sequences of frames, while continuously and selectively reviewing the first sequence (paragraphs [0035-36]).

In regard to claim 2, Sisselman further teaches that the device controller loops back to a first sequence and overwrites the first sequence of frames with a second sequence of frames and with a third or fourth sequence after that (see paragraph [0033] and FIG. 6).

With regard to claims 5 - 7, the device of Sisselman is a camera with a magnifying (zoom) feature, and as such is effectively a camera, telescope or microscope when the functions it is capable of performing are taken into consideration.

As to claim 8, Sisselman teaches a digital record and replay binoculars.

As to claim 12, the only viewing means that the device of Sisselman has is the display (120), which is built-in into housing (110) (see FIGS. 1-4; paragraph [0025]).

As to claim 13, the controller enables a user to select when to display a sequence of frames of predetermined duration (see relevant function of replay button 190 in paragraphs [0028] and [0031]).

With respect to claim 14, Sisselman teaches the device corresponding method, wherein a sequence of frames of predetermined duration is recorded and consequently is overwritten by a following sequence of frames, and in response to a user selection allows to the user to view a

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recorded sequence of frames (see related discussion regarding claim 1). The predetermined duration is user definable because depending on number of actuations of replay button (paragraph [0034]).

As to claim 15, Sisselman further teaches that the aforementioned method includes storing a first sequence and then looping back to the beginning of the first sequence and overwriting the first sequence with a second sequence of frames (see also discussion related to claim 2).

In regard to claim 16, the method involves an integral number of sequences of frames of predetermined duration.

As to claims 17 and 18, Sisselman further teaches that the method enabling a user to select to view either real time scene or recorded sequence of frames by choosing a playback mode (paragraph [0028]).

As to claim 19, Sisselman teaches a processor-based system for implementing a method of recording, overwriting and selectively viewing a recorded sequence of frames. While Sisselman does not explicitly teach that the processor includes a medium for storing instructions that enables it to execute the aforementioned method, it is notoriously known that the processor-based systems inherently have a medium for storing instruction that are being executed by the processor in order to make the processor-based system viable (see, for example a flow-chart in FIG. 8 reflecting a program executed by the processor). It is obvious that while the first loop, (sequence of frames in A,B and C) is being repeatedly viewed by a user at user's request, the second loop (leftover segments H-D) are being overwritten without overwriting the first one.

As to claim 20, see discussion related to claim 2.

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As to claim 21, see discussion related to claim 3.

As to claims 22 and 23, see rejection related to claim 13.

6. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sisselman, as applied to claim 1 above, and further in view of Kawamura et al., (hereinafter Kawamura), US 5,153,569 (both references are references of record).

Sisselman does not disclose an optic element to enable the user to selectively view a scene or the display through the optic element.

Kawamura teaches a personal viewing device (FIGS. 10-11) capable of delivering real scene or recorded image displayed on a display to a user, and having an optic element (shutter) for selectively view a scene or the display (FIG. 4; col. 3, line 47 - col. 4, line 17).

It would have been obvious to one of ordinary skill in the art at the time when the invention was made to modify the viewing device of Sisselman with optical arrangement of Kawamura, because it would improve the former with the ability to switch between viewing a real scene or pre-recorded images from the display at user's discretion without the viewer's need to take off the viewing device (Kawamura; col. 7, lines 19-28).

As to claim 9, Kawamura teaches a beam splitter (2) arranged to pass light from the scene (through the shutter 3) or from the display (7).

As to claim 10, Kawamura teaches the shutter (3) to control viewing access to the optic element (beam splitter 2).

As to claim 11, Kawamura further teaches that the device selectively enables a user to view the display or a scene through the optic element.

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Response to Arguments

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection presented above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (571) 272-7687. The examiner can normally be reached on M-F (9:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Eisen
Primary Examiner
Art Unit 2674

June 9, 2005